



Atty. Dkt. No. 038602-1200

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peng Cho TANG et al.

Title: INDOLINONE DERIVATIVES AS PROTEIN KINASE/PHOSPHATASE INHIBITORS

Appl. No.: 09/871,700

Filing Date: 6/4/01

Examiner: M.G. Baker

Art Unit: 1627

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Box NON-FEE AMENDMENT
Washington, D.C. 20231

Sir:

In response to the restriction requirement set forth in the Office Action mailed August 15, 2002, Applicants hereby provisionally elect Group II, claims 8 - 15, drawn to the compound of formula II, for examination, with traverse. Applicants traverse the restriction requirement on the ground that there is no undue burden on the Examiner to examine Groups I and II together.

Applicants concurrently file herewith a Petition for Extension of Time under 37 C.F.R. § 1.136(a), with provision for the required fee, to extend the period for response to November 15, 2002. If additional fees are necessary to prevent abandonment of this application, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741.

It is respectfully submitted that pursuant to the Official Gazette notice of March 26, 1996, which establishes guidelines for treatment of product and process claims in light of *In re Ochiai*, claims drawn to methods (claims 20 - 25) should be included herein for consideration on the merits. At the minimum, method of use claims of the same scope as the product claims should be rejoined when the product claims are found to be allowable.

The Examiner has also required Applicants to elect a single species pursuant to 35 U.S.C. § 121, from whichever group is elected, even though this requirement is

traversed. Applicants hereby elect the species disclosed in Example 48, on page 87:
3-[5-(2-morpholin-4-yl-ethoxy)-1H-indol-2-ylmethylene]-2-oxo-2,3-dihydro-1H-indol-5-sulfonic acid amide.

It is understood that should the Examiner find claims that read on the above-mentioned species allowable, then the search and examination of the entire application will proceed according to the procedure set forth in MPEP § 803.02.

Applicants, of course, reserve the right to file one or more divisional applications covering the subject matter of the non-elected claims.

Applicants respectfully request examination on the merits of this application. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date

11/15/02

FOLEY & LARDNER

Customer Number: 22428



22428

PATENT TRADEMARK OFFICE

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Respectfully submitted,

By

Beth A. Burrous

Attorney for Applicant

Registration No. 35,087



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: Maurie Garcia Baker, Ph.D.

ART UNIT: 1627

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

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FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: _____

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